

REMARKS/ARGUMENTS

Claims 1-44 are pending.

Favorable reconsideration is respectfully requested in view of the following remarks.

Rejection under 35 U.S.C. 102(b)

Claims 1-4 and 38 stand rejected under 35 U.S.C. 102(b) as being anticipated by Van Lommen et al., EP 145067. This rejection is respectfully traversed.

In Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (MPEP 2131), the CAFC set forth that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference". In the instant case, not every element of the claims is present in the EP 145067 reference. The Examiner cites Example 22 of EP 145067.

Claims 1-4 are directed to processes for preparing acid addition salts of the compounds of Formula I by forming an acid addition salt of an N-protected compound of formula I, then the salts are subjected to fractional crystallization to obtain the desired diastereomeric pair from the mixture of diastereomeric pairs. The EP 145067 reference discloses processes for preparations of neбивол which involve chromatographic separations for the separation of diastereomeric pairs at the intermediate stage or at the final stage. This is in contrast to the instant claims, which are directed to processes using fractional crystallization. Fractional crystallization allows the purification of the disclosed N-protected compounds from the reaction mass, thereby avoiding multiple purifications of crude neбивол. The separation of the diastereomers of the N-protected compounds by fractional crystallization is not disclosed in the cited art.

Claim 38 is directed to acid addition salts of formulas I and II. Compounds comprising the allyl or substituted benzyl protecting groups as set forth in the claim are not disclosed in EP 145067, nor are acid addition salts of these compounds.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. 103(a)

Claims 1-44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Van Lommen et al. This rejection is respectfully traversed.

The Examiner sets forth that EP 145067 teaches the fractional crystallization of acid salts of N-araalkyl and N-allyl protected salts of neбиволol in the purification of the desired racemic pair of enantiomers of neбиволol, citing Ex. 22 and 23.

The Examiner admits that ethanol is the only solvent disclosed and the oxalic acid is the only acid addition salt purified, the Examiner argues that the instant use of other solvents and mineral acids and other organic acids would have been obvious to one of ordinary skill in the art.

The claims are patentable over the EP 145067 reference for the following reasons. The framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows: (A) Determining the scope and content of the prior art; and (B) Ascertaining the differences between the claimed invention and the prior art; and (C) Resolving the level of ordinary skill in the pertinent art. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970). MPEP 2143.03. It is important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. (KSR v Teleflex, 12 S.Ct. 1727, 1740 (US 2007)).

Claims 1-37, and 43-44 are directed to processes for preparing acid addition salts of the compounds of Formula I by forming an acid addition salt of an N-protected compound of formula I, then the salts are subjected to fractional crystallization. The separation of the diastereomers of these N-protected compounds by fractional crystallization is not taught or suggested in the cited art.

The EP 145067 discloses processes for preparations of neбиволol which involve chromatographic separations for the separation of diastereomeric pairs at the intermediate stage or at the final stage. These chromatographic separations involve additional operations, additional expensive setup adding to the cost of production. In contrast to the disclosure of EP 145067, the instant claims are directed to processes using fractional crystallization to obtain the desired diastereomeric pair from the mixture of diastereomeric pairs. Fractional crystallization allows

the purification of the N-protected compounds from the reaction mass, thereby avoiding multiple purifications of crude nebevivolol.

Furthermore, there is no motivation for one of skill in the art to alter the methods of EP 145067 to arrive at the claimed method, and no reasonable expectation of success. There is no teaching or suggestion within EP 145067 to alter the method disclosed to arrive at the instantly claimed method. Since the EP 145067 reference does not disclose or suggest all the limitations of the claims, there is no motivation to reach these limitations, and no expectation of success.

With regard to claims 38-42, the claims are directed to acid addition salts of formulas I and II, and further wherein the salts are hydrogen halides, hydrogen sulfates, sulfates and sulfonic acid salts. Compounds comprising the allyl or substituted benzyl protecting groups as set forth in the claims are not disclosed or suggested in EP 145067, nor are the acid addition salts of these compounds.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

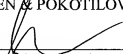
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For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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